

added to more clearly recite aspects of the invention. Applicant believes no new matter has been introduced by the amendment and the new claim presented herein. The amendment and new claim has been made in a good faith effort to advance the prosecution on the merits. Claims 10 and 13 have been cancelled without prejudice. Applicant reserves the right to subsequently take up prosecution of the claims as originally filed in this application in a continuation, a continuation-in-part and/or a divisional application. Please reconsider the claims pending in the application for reasons discussed below.

Claim 14 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,255,751 ("*Stogner*"). *Stogner* generally describes a drill pipe make-up and breakout tool, which includes an upper housing supported on a lower housing by a plurality of spring biased legs. The lower housing has a plurality of spring-biased legs disposed therebelow. The upper housing has a reversible rotatable jaw for rotating a pipe having a pin. A hydraulic motor provides the motive force to the reversible jaw. The lower housing has a fixed jaw for holding a pipe having a box. The spring-biased legs allow for lateral and longitudinal play in the upper and lower housings to facilitate proper alignment between the pin and the box. However, *Stogner* does not teach or disclose adjusting the supporting member to cause the tool to be displaced horizontally relative to the top drive. The Examiner takes the position that the upper housing is equivalent to the support member recited in the claims. As such, *Stogner* mentions nothing about adjusting the upper housing to cause the tool to be displaced horizontally. Accordingly, claim 14 is patentable over *Stogner*.

Claims 1-3, 5-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,255,751 ("*Stogner*") in view of U.S. Patent No. 4,625,796 ("*Boyadjieff*"). As described above, *Stogner* generally describes a drill pipe make-up and breakout tool, which includes an upper housing supported on a lower housing by a plurality of spring biased legs. However, *Stogner* does not teach, disclose or even suggest a supporting member for supporting a tool and a means for allowing substantially horizontal movement of said supporting member. In fact, *Stogner* mentions nothing about the upper housing, which is the element the Examiner has deemed equivalent to the supporting member, having a means for allowing substantially

horizontal movement of the supporting member. Rather, the spring-biased legs merely allow lateral and longitudinal play of the pin and the box without moving the upper housing laterally.

Boyadjieff is generally directed to an apparatus for connecting a pipe to an upper end of a drill string. The upper end of the string is connected to a top drive drilling unit 19, which is configured to rotate and move the string up and down. A pipe handler 21 is suspended from the drilling unit 19 and is configured to suspend the string and to make and break threaded connections at the bottom of the drilling unit 19. The pipe handler 21 includes a torque wrench 42, an elevator 43 suspended from a carrier part 44 through two links 45, a link tilting mechanism 158 for swinging the links 45 and the suspended elevator 43 sideways, and a pair of torque arrestors 46 for retaining the carrier part 44 against rotation. The pipe handler 21 may be connected to the drilling unit 19 through an assembly 48, which is configured to retain the pipe handler 21 against rotation during drilling. The link tilting mechanism 158 includes a rigid member 159, which is pivotally connected to the carrier part 44 and is configured to swing about a horizontal axis when a fluid actuated bellows 163 positioned between the carrier part 44 and the rigid member 159 is actuated. When the rigid member 159 and the links 45 are swung laterally, the elevator 43 is displaced to a side of the well axis, thereby enabling the elevator 43 to engage and pick up a pipe. However, *Boyadjieff* does not teach, disclose or even suggest a supporting member for supporting a tool and a means for allowing substantially horizontal movement of said supporting member.

Neither *Stogner* nor *Boyadjieff*, alone or in combination, teaches or discloses a supporting member for supporting a tool and a means for allowing substantially horizontal movement of said supporting member. Furthermore, there is no suggestion discerned in *Stogner* or *Boyadjieff* of modifying the devices or methods disclosed therein in the direction of the present invention, nor does there appear to be any suggestion of the desirability of such modifications. Therefore, claim 1 is patentable over *Stogner* in view of *Boyadjieff*. Claims 2-3 and 5-13 are also patentable over *Stogner* in view of *Boyadjieff* since they depend from claim 1.

Furthermore, *Stogner* does not teach, disclose or suggest adjusting the supporting member to cause the tool to be displaced horizontally relative to the top

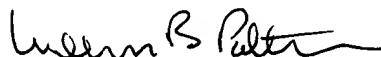
drive. In fact, *Stogner* mentions nothing about adjusting the upper housing, which the Examiner has deemed equivalent to the supporting member, to cause the tool to be displaced horizontally. *Boyadjieff* also does not teach, disclose or even suggest adjusting the supporting member to cause the tool to be displaced horizontally relative to the top drive. Neither *Stogner* nor *Boyadjieff*, alone or in combination, teaches or discloses adjusting the supporting member to cause the tool to be displaced horizontally relative to the top drive. Furthermore, there is no suggestion discerned in *Stogner* or *Boyadjieff* of modifying the devices or methods disclosed therein in the direction of the present invention, nor does there appear to be any suggestion of the desirability of such modifications. Therefore, claim 14 is patentable over *Stogner* in view of *Boyadjieff*.

The Examiner has rejected various dependent claims. However, because the rejections to the respective base claims have been overcome, Applicant submits that the rejections for the dependent claims are obviated.

In conclusion, the references cited by the Examiner, neither alone nor in combination, teach, show, or suggest the method or apparatus of the present invention. Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

The prior art made of record is noted. However, it is believed that the secondary references are no more pertinent to the Applicant's disclosure than the primary references cited in the office action. Therefore, it is believed that a detailed discussion of the secondary references is not deemed necessary for a full and complete response to this office action. Accordingly, allowance of the claims is respectfully requested.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

2. (Amended) An apparatus as claimed in Claim 1, wherein said means [also] allows substantially vertical movement of said supporting member.